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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/081,564 | 02/22/2002 | Victor Kadziela | 500-151 (LC-442) | 1987 |
| 7590 | 03/15/2004 | | EXAMINER | |
| Daniel A. Scola, Jr. HOFFMANN & BARON, LLP 6900 Jericho Turnpike Syosset, NY 11791 | | | SERGENT, RABON A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

| | | | |
|------------------------------|---------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/081,564 | KADZIELA ET AL. | |
| | Examiner Rabon Sargent | Art Unit 1711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 January 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 1,6,8-15 and 18-24 is/are allowed.

6) Claim(s) 2-5,7,16 and 17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

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1. Claims 2-5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 2-5, it is unclear if the language, “a di-functional monomer” and “a mono-functional monomer”, corresponds to the di- or poly-functional urethane acrylate monomer and the mono-functional urethane acrylate monomer, respectively, of claim 1. Furthermore, despite applicants’ response, the position is taken that the claim language as set forth introduces an unnecessary degree of ambiguity into the claims. Applicants should clarify the claim language to make it clear that the monomers of claims 2-5 correspond to the monomers of claim 1.

Within claim 7, it is unclear if the language, “a polyester aliphatic urethane-acrylate”, further defines one of the specified monomers within claim 1 or represents a component in addition to the monomers of claim 1. The relationship of the polyester aliphatic urethane-acrylate to the recited components within claim 1 should be clarified.

2. Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for curable compositions having a Shore A hardness of about 55 or less, when cured, does not reasonably provide enablement for compositions having high hardness values, when cured. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Throughout the specification, applicants have stressed that the curable compositions of the instant invention have a Shore A hardness of about 55 or less when cured. Furthermore, applicants have failed to provide adequate guidance for modifying the disclosed compositions to

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yield viable, cured compositions having higher hardness values; therefore, the position is taken that applicants' claims should be limited to compositions that have the disclosed hardness value when cured.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Tortorello et al. ('021 or '361).

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Patentees disclose radiation curable glass fiber coating compositions comprising a polyfunctional urethane acrylate, a monofunctional urethane acrylate, a reactive diluent, and a photoinitiator, each of which corresponding to the claimed components, wherein the components are used in quantities that meet those claimed. See abstract and columns 2-7, especially column 7, lines 25-43.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tortorello et al. ('021 or '361) in view of Szum et al. ('593).

As aforementioned, Tortorello et al. disclose radiation curable compositions comprising a polyfunctional urethane acrylate, a monofunctional urethane acrylate, a reactive diluent, and a photoinitiator, wherein the components are used in quantities that meet those claimed.

6. However, while the polyfunctional urethane acrylate, the monofunctional urethane acrylate, and the photoinitiator correspond to those claimed by applicants, patentees fail to disclose the use of 2(2-ethoxyethoxy)-ethylacrylate as the reactive diluent. Still, 2(2-ethoxyethoxy)-ethylacrylate was a known reactive diluent for radiation curable fiber coating compositions at the time of invention. Szum et al. disclose the use of ethoxyethoxy ethylacrylate in such an application. Therefore, since it has held that it is obvious to utilize a known compound for its known function, the position is taken that it would have been obvious to utilize the known reactive diluent within the invention of Tortorello et al. *In re Linder*, 173 USPQ 356; *In re Dial et al.*, 140 USPQ 244.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
March 6, 2004

Rabon Sergent
RABON SERGENT
PRIMARY EXAMINER